



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/173,858	10/16/1998	BART ALAN MELTZER	19957.701	4734

22470 7590 08/26/2002

HAYNES BEFFEL & WOLFELD LLP
P O BOX 366
HALF MOON BAY, CA 94019

EXAMINER

HUYNH, CONG LAC T

ART UNIT	PAPER NUMBER
----------	--------------

2176

DATE MAILED: 08/26/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicati n N .

09/173,858

Applicant(s)

MELTZER ET AL.

Examin r

Cong-Lac Huynh

Art Unit

2176

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 June 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 and 61-72 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16, 61-72 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 15.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. This action is responsive to communications: request for reconsideration filed on 1/2/02 to the application filed on 10/16/98.
2. Claims 1-16, 61-72 are pending in the case. Claims 1 and 61 are independent claims.
3. The rejections of claims 61-72 under 35 U.S.C. 101, as being directed to non-statutory subject matter have been withdrawn in view of Applicants' arguments.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
5. Claims 1-16, 61-72 remain rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding independent claim 1, it is not clear what the claimed interface is since the preamble mentions of the interface but the limitations of claim 1 refer to a machine-readable specification of the interface, the interpretation information of the input document and the interpretation information of the output document.

It was well known that the operations implementing in a program are the steps to show how the program works. The specification of the interface, the definitions of the input documents and the definitions of the output documents are not the operations on the

Art Unit: 2176

interface data of the interface program. Therefore, there is nothing about the steps of how the interface works.

Claims 2-16 are also rejected as being dependent on claim 1.

Regarding independent claim 61, it is not clear what the programming of a commercial transaction is since the limitations of claim 61 only includes *defining a machine readable definition* of an input document and *a machine readable definition of an output document*, and *providing interpretation information* for the logical structures to the node. "Defining a machine readable definition of an input document..." and "providing interpretation information..." are defining data for a program. There are no actions based on the data provided to run the program to be claimed. Therefore, the limitations of the claims do not show how the programming of a commercial transaction works.

Claims 62-72 are also rejected as being dependent on claim 61.

Claim Rejections - 35 USC § 101

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claims 1-16 remain rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Art Unit: 2176

Claim 1 refers to a *machine-readable specification* of an interface which includes *interpretation information* providing a *definition of an input document and an output document*. A machine readable specification of an interface and the interpretation information of the definitions of an input document and an output document with respective descriptions of set of storage units and logical structures for the sets of storage units are information data for describing what the interface is. Said information is not a set of instructions of a program, which are functional, to solve a problem or to show how an interface of a transaction works. The claim, therefore, does not recite any functional subject matter.

Claims 2-16 are also rejected as being dependent on claim 1.

Response to Arguments

8. Applicant's arguments filed 6/12/02 have been fully considered but they are not persuasive.

Applicants argue that claim 1 is not indefinite as required under 35 U.S.C. 112, second paragraph, since the interface recited in the preamble can be used in many ways.

Applicants explain that the operation of a computer system implementing the interface is independent of the specification of input and output document of the interface.

Applicants assert that said operations are not relevant to the claims since it is the structure of the interface that is claimed.

Art Unit: 2176

Examiner disagrees.

In the preamble, the interface for transactions among nodes in a network is introduced.

But in the body, what is claimed does not appear to have any relation to the interface.

Applicants admit that operations implementing interface is independent to I/O documents of the interface and only claim the definitions of the I/O documents. The limitations of the claim, which are the definitions of the I/O documents, therefore, do not show the steps of how the interface for transactions works, as introduced in the preamble.

Regarding independent claim 61, Applicants argue that the claim is not indefinite since the programming of the commercial transaction is accomplished by first “defining a machine readable definition of an input document... ” and “providing interpretation information for the logical structure...” The steps in the claims, therefore, support the method for programming of a transaction introduced in the preamble.

Examiner disagrees.

“Defining a machine readable definition of an input document ...” and “providing interpretation information...” are *defining data for a program*. By definition, to program is to provide (a computer) with a set of instructions for solving a problem. In the claim, there are *no actions based on the data provided to run a program to be claimed*, but instead the I/O document definition and interpretation information. Therefore,

Art Unit: 2176

“defining...” and “providing...” do not show how the programming of an interface for transaction works but instead merely providing data.

Applicants argue the rejection of claim 1 under 35 U.S.C. 101 as directed to non-statutory subject matter is not proper since claim 1 recites “functional descriptive material” consisting of data structures and computer programs stored in memory.

Examiner disagrees.

Claim 1 recites “a machine readable specification of an interface...” and including interpretation information “providing a definition of an input document, and a definition of an output document...”

A machine readable specification of an interface and the interpretation information of the definitions of an input document and an output document with respective descriptions of set of storage units and logical structures for the sets of storage units are information data for describing what the interface is. Said information is not functional since it is not a set of instructions of a program, which are functional, to solve a problem or to show how an interface of a transaction works.

Even when a specification of an interface or the definitions of an input document and the definitions of an output document are encoded and stored in memory, the specification and the definitions are merely data without any function. They are not instructions providing the computer to do something in a program. Therefore, the specification and the definition data as claimed are non-functional data structures.

Art Unit: 2176

Further, as admitted by Applicants, the structure of the interface is claimed. It is clear that the structure of the interface is not an action or a function. Therefore, the structure of the interface is not functional.

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cong-Lac Huynh whose telephone number is 703-305-0432. The examiner can normally be reached on Mon-Fri (8:30-6:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon can be reached on 703-308-5186. The fax phone numbers for the organization where this application or proceeding is assigned are 703-

Application/Control Number: 09/173,858

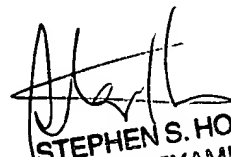
Page 8

Art Unit: 2176

305-9731 for regular communications and 707-305-9731 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-9000.

clh
8/20/02


STEPHEN S. HONG
PRIMARY EXAMINER